

REMARKS

The Office Action mailed May 7, 2004 has been reviewed and carefully considered.

Claims 1-21 are pending in this application.

The Examiner has objected to the Amendment filed on March 24, 2004 because the Examiner's believes the Amendment introduces new matter into the disclosure. The Applicants respectfully disagree with the Examiner's position, but nonetheless have deleted the paragraph in issue, as the Applicants believe that the paragraph is not even needed to provide support in the specification for a combined embodiment of the present invention that encompasses both directory and voice mail services. Thus, reconsideration of the objection is respectfully requested.

Claims 10-13 stand rejected under 35 U.S.C. §112, first paragraph as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Applicant respectfully disagrees.

While the Examiner has stated that there is no single integrated embodiment which discloses directory assistance and voice mail together, the Applicants respectfully point out to the Examiner that both directory assistance and voice mail hardware are shown in Figure 1, wherein common elements for both directory assistance and the voice mail are shown operatively connected to each other. For example, the server 16 shown in Figure 1 is disclosed to include a voicemail server that receives and records messages through a DSL network (i.e., the SAME DSL network as the directory services, since they are all interconnected in Figure 1) (Applicant's specification, p. 10, lines 17-19). Clearly, from Figure 1 alone, it is

evident that the specification shows an embodiment (a system) having both directory assistance and voice mail services.

Moreover, the sentence in the Applicant's specification that "[t]he embodiment employing voicemail server 16 works in much the same way as the directory services application described herein", in light of the fact that common hardware for both the directory and voicemail services is not only shown in the same figure (Figure 1) but is also interconnected in that figure, provide a teaching to one of ordinary skill in the related art that the directory services and the voicemail services may be integrated in some embodiments of the present invention. For example, the elements are shown together, are connected together, and operate similarly. That is, the apparatus shown in FIG. 1 is utilized and described for both directory assistance (see, e.g., Applicants' Specification, p. 7, lines 15-28, p. 9, lines 1-3) and voicemail services (e.g., Applicants' Specification, p. 10, lines 13-20) and FIG. 1 shows all the elements in Claims 1 and 10.

The Examiner has pointed to a particular sentence of the Applicant's specification to support his position. Namely, page 10, lines 12-13 of the Applicant's specification, discloses that "[i]n an alternate embodiment, an advanced telephone user interface is employed for voice mail". However, that sentence is simply stating for voice mail, a more advanced user interface is employed (than what would be employed for only directory services), and the following sentence continues by disclosing that a display screen may include a voice mail message icon to indicate that one or more voice mail messages are available. No user interface is shown in Figure 1.

Further, the Applicants point out to the Examiner that the Applicant's specification explicitly states that "it is noted that modifications and variations can be

made by persons skilled in the art in light of the above teachings” (Applicant’s specification, p. 12, lines 29-30). Accordingly, the Applicant’s respectfully ask the Examiner how could one of ordinary skill in the art, given the fact that the common hardware for both directory and voicemail services are shown and interconnected to each other in Figure 1, could lead such person to not immediately believe both services to be combinable, especially when they are essentially shown combined in Figure 1.

It is therefore respectfully submitted that support for this combination of elements is clearly disclosed in the figures and specification and that the inventors had possession of the combination at the time the application was filed. Reconsideration of the rejection is earnestly solicited.

Claims 1-5, 8, 9, and 14-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Smith et al. (hereinafter “Smith”) in view of Gerszberg et al. (hereinafter “Gerszberg”). Claims 6, 7, 20, and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Smith et al. (hereinafter “Smith”) as modified by Gerszberg as applied to Claims 1-5, 8, 9, 14-19 above, and further in view of Desmond et al. (hereinafter “Desmond”). Claims 1-5, 8, 9, and 14-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Braun et al. (hereinafter “Braun”) in view of Gerszberg. Claims 6, 7, 20, and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Braun as modified by Gerszberg as applied to Claims 1-5, 8, 9, 14-19 above, and further in view of Desmond. Claims 1-5, 8, 9, and 14-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Schlachman et al. (hereinafter “Schlachman”) in view of Gerszberg. Claims 6, 7, 20, and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Schlachman as modified by Gerszberg as

applied to Claims 1-5, 8, 9, 14-19 above, and further in view of Desmond. The rejections are respectfully traversed.

The present invention is directed to the problem of delivering directory data or other information directly to a telephone or other device over a digital signal line network (see Applicants' specification, page 1, line 33 to page 2, line 1). The admitted prior art involves either looking up directory information in the Yellow or White Pages or by calling the information service over an analog signal line network and speaking with an operator (see Applicants' specification, page 1, lines 20-24).

It is quite noteworthy that the cited prior art references that mention directory information do NOT involve a Digital Subscribers Line (DSL) telephone network. For example, the Examiner has explicitly stated in the Office Action that "Smith/Braun/Schlachman differs from the claimed invention in not disclosing the telecommunication device being connected to a DSL telephone network" (Office Action, pages, 3, 5, and 7)(emphasis added).

To further support his position, in particular, to provide a reference showing a DSL telephone network, the Examiner has relied upon Gerszberg, which is directed to a videophone **BLOCKER** (Gerszberg, Title). However, the Applicants respectfully assert that Gerszberg is non-analogous art and is, thus, not applicable to a rejection of the pending claims.

To establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP §2143. Smith is directed to an "automatic transfer of electronic directory entries from directory assistance service to a directory within an electronic communication device (Smith, Title). Braun is directed to a "system and

method for providing directory information over a telephony network using ADSP” (Braun, Title). Schlachman is directed to an “apparatus for enabling a telephone user to obtain directory information” (Schlachman, Title). In contrast, Gerszberg is directed to a videophone blocker (Gerszberg, Title). In particular, Gerszberg discloses “[a] videophone with selective privacy control of a caller’s transmitted image” (Gerszberg, Abstract).

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) (*see also*, MPEP §2141.03)).

Accordingly, while Smith, Braun, Schlachman are respectively directed to TRANSFERRING directory entries, PROVIDING directory information, and OBTAINING directory information, Gerszberg is dissimilarly directed to BLOCKING data, and thus, teaches away from any combination with any of Smith, Braun, and Schlachman. That is, one seeking to transfer, provide, or obtain data to/for a telephone user would not consult patents on blocking data to a telephone (or videophone) user, as the two concepts (providing data versus blocking data) diverge 180 degrees. There certainly would not be any suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings when one reference involves providing data previously unavailable and the other reference involves blocking available data. Accordingly, Applicants respectfully assert that Gerszberg is non-analogous art and its use is inappropriate in any rejections of the pending claims.

Accordingly, Applicants respectfully assert that none of Smith, Braun, Schlachman, or Gerszberg, either taken singly or in any combination, disclose all of

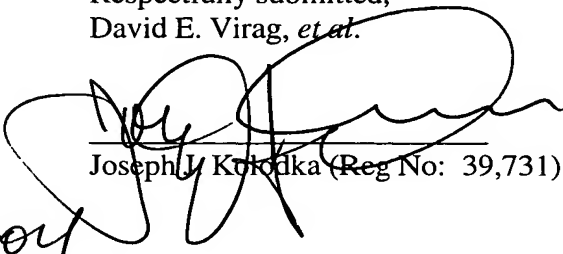
the limitations recited in independent Claims 1 and 14. Moreover, assuming *arguendo* that Gerszberg even discloses the limitations relating to DSL in Claims 1 and 14 for which the Examiner relied, such limitations cannot be shown in Gerszberg because Gerszberg is non-analogous art and, thus, cannot be combined with any of Smith, Braun, Schlachman. Thus, Claims 1 and 14 are patentably distinct and nonobvious over the cited references for at least the reasons set forth above.

Claims 2-13 depend either directly or indirectly from Claim 1 and, thus, contain all of the limitations of Claim 1. Claims 15-21 depend either directly or indirectly from Claim 14 and, thus, contain all of the limitations of Claim 14. Thus, Claims 2-13 and Claims 15-21 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above with respect to Claims 1 and 14, respectively. Reconsideration of the rejection is respectfully requested.

In view of the foregoing, Applicants respectfully request that the rejection of the claims set forth in the Office Action of May 7, 2004 be withdrawn, that pending claims 1-21 be allowed, and that the case proceed to early issuance of Letters Patent in due course.

It is believed that no additional fees or charges are currently due.
However, in the event that any additional fees or charges are required at this time in connection with the application, they may be charged to applicant's Deposit Account No.07-0832.

Respectfully submitted,
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